UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,435	08/17/2001	Hongjie Cao	1942	3469

35157 7590 05/25/2006

NATIONAL STARCH AND CHEMICAL COMPANY
P.O. BOX 6500
BRIDGEWATER, NJ 08807-3300

EXAMINER	
GOLLAMUDI, SHARMILA S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/932,435	Applicant(s) CAO ET AL.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 30 April 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

Applicant argues that JP 11-236310 does not teach heat-treating the gum to the instant moisture content since JP's discloses that the drying decrease should be 50%. Applicant argues that JP teaches heating the xanthan gum in water and water vapor and thus will not have the instant moisture content. Applicant argues that JP broadly discloses the instant heat-treated xanthan gum in cosmetics and does not specifically teach the gum a hair composition. Applicant argues that JP does not teach a composition that would exhibit 80% curl retention and does not mention the hair fixative ability of the gum. Lastly, applicant argues that claims 29-32 only claim xanthan gum and JP specifically teaches away from xanthan gum.

Applicant's arguments have been fully considered but they are not persuasive.

Firstly, it should be noted for the record and at applicant's request, the examiner's statement in the previous Office Action that "Applicant has made a misleading statement" is retracted. However, the examiner maintains her position that JP anticipates the instant invention. Applicant argues JP teaches, "the raw material xanthan gum should have a drying decrease of not more than 50%, with only 15% or less preferred". Applicant acknowledges the definition of drying decrease. JP defines drying decrease as the decrease in quantity when the gum is heated for 5 hours at 105 degrees Celsius. The examiner points out that xanthan gum inherently contains water and this water is driven off when heated; thereby decreasing the quantity of gum since it is concentrated. JP teaches that the "raw material" should have a 50% or less drying decrease with the drying decrease of 15% being preferred, meaning that the starting material must have the ability to be dried to a level of 50% or preferably less than 15%." Example 1 teaches a drying decrease of 12%. Firstly, JP's disclosure is not equivalent to "the gum should be *only* dried to 50%" as argued by applicant since the lower amount of 15% and less is preferred as evident by

the example. Moreover, it is pointed out that the independent claims do not require any specific moisture content.

With regard to applicant's argument that JP heats the gum using water vapor, the examiner points out that JP teaches various methods in which the gum is heated. Firstly, it is pointed out that water is not taught as one of the liquids used in heating the gum. Secondly, the examiner points although water vapor as one of the gases utilized to dry the gum, JP notes that the gas used does not react with the gum. Therefore, moisture is not added as argued by applicant. Moreover, JP also teaches that heating must reduce the moisture content below 12%. The examiner points out that ***dependent*** claim 4 is directed to heating to 105 degrees Celsius. The examiner points to the working example wherein the gum is heated treated under vacuum at a temperature of 115 degrees C for 3 hours. This is enough to anticipate the claims. Further, if JP discloses the same time and temperature, then the moisture content would be inherent. The examiner points to MPEP 2112 (IV) wherein the examiner must provide a rationale for inherency; however once the examiner has provided a rationale for inherency, the burden shifts to the applicant. See MPEP 2112 (V). Applicant has not provided any evidence to the contrary, i.e. evidence that JP's xanthan gum dried under vacuum at a temperature of 115 degrees Celsius for 3 hour does not have the instantly claimed moisture content.

Moreover, it is noted that applicant argues the process of making the heat-treated xanthan gum but the claims do not require any process steps.

With regard to the intended use argument, the examiner points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the examiner points out that the composition can be used on the hair or skin as taught on page 11, last column. Therefore, JP's composition is capable of performing the recited intended use. Moreover, the examiner points out that page 7 of the instant specification defines the hair fixative amount to be 0.01-20% and JP teaches 0.01-2%. Thus, the JP is clearly capable of performing the intended use, i.e. a hair fixative cosmetic composition since example 1 discloses a composition containing 0.01-0.09% of the gum. The examiner also points out that JP teaches the same xanthan gum as claimed by applicant and compositions containing the gum (a 0.01-0.09% solution of the heat treated gum in example 1), this is enough to anticipate the instant claims. The prior art does not have to recognize every inherent feature of a product. Moreover, the fact that the applicant has recognized another property of the prior art's xanthan gum, which would flow naturally from the prior art cannot be the basis for patentability. See In re Best.

In response to applicant's arguments, the recitation hair composition has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

With regard to the curl retention, note the discussion regarding the Rule 132 declaration.

With regard to the functional limitation, the examiner points out that the same xanthan gum with the same viscosity is being claimed and thus both must have the same properties. The examiner points to MPEP 2112.01 II: IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES.

Applicant argues that JP briefly mentions that the xanthan gum can be used in hair cosmetic composition however all the examples are directed to skin compositions. Applicant argues that JP does not teach every element of the claim and thus cannot be rendered obvious.

The examiner has discussed the merits of JP above and it is the examiner's position that the moisture content is inherent. As acknowledged by the applicant, JP does suggest the use of the heat-treated xanthan gum in hair cosmetics. Although the examples are directed to skin care compositions, the examiner points out that disclosed examples and preferred embodiments do not constitute a teaching away form the broader disclosure or nonpreferred embodiment". See *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Lastly, the examiner points out that the claims are rejected under obviousness; thus JP does not need to exemplify the instant methodology of applying the composition to the hair.

With regard to the turbidity, the examiner points out that JP teach the same polymer in water and thus the prior art's composition (Reference example 2) must have the same turbidity.

The rejections are maintained for the reasons set forth in the Final Office Action of 11/2/05.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sharmila S. Gollamudi
Examiner
Art Unit 1616

Johann Richter, Ph.D. Esq.
Supervisory Patent Examiner
Technology Center 1600